



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,413	01/25/2002	Anthony G. Martin	50642.00022	8375
30256	7590	06/08/2005	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P 600 HANSEN WAY PALO ALTO, CA 94304-1043			NGUYEN, HAI V	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/057,413	MARTIN ET AL.
	Examiner Hai V. Nguyen	Art Unit 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-48 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-48 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the communication received on 29 April 2005.
2. Claims 1-48 are presented for examination.

Response to Arguments

3. Applicant's arguments filed on 29 April 2005 have been fully considered but they are not deemed to be persuasive. Applicant's arguments are deemed moot in view of the following new ground(s) of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., collecting at a client information about a user, *the information about the user including navigation behavior of the user, the navigation behavior being monitored at the client*) to the claims which significantly affected the scope thereof.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 8-14, 30-36, 46 are rejected under 35 U.S.C. 101 because the claimed invention is non-functional descriptive material and is directed to non-statutory subject matter. Claims 8, 30, 46 describe the "logic" element, which when read in light of specification amounts to nothing more than computer software void of a computer readable medium. See MPEP 2106(IV)(B)(1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mathai et al. U.S. patent #: 6,847,969 B1** in view of **Chen et al. U.S patent # 6,857,024 B1**.

8. As to claim 1, Mathai, Method And System For Providing Personalized Inline Services And Advertisements In Public Spaces, discloses a method for presenting information, comprising:

collecting at a client information about a user, the information about the user including navigation behavior of the user, the navigation behavior being monitored at the *client (Mathai, whenever the user inserts the system access card into a system terminal, the system automatically updates and enriches the user profile by tracking the user's usage of the system in a usage history record (col. 4, lines 26-30; col. 5, lines 24-63))*; However, Mathai does not explicitly disclose transmitting via a network the collected information from the client to a location for generating a user profile for the user based on the collected information, wherein content is selected for the user based on the generated user profile; receiving the content at the client via the network; and presenting the content to the user at the client. Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus

Art Unit: 2142

for implementing transmitting via a network the collected information from the client to a location for generating a user profile for the user based on the collected information, wherein content is selected for the user based on the generated user profile; receiving the content at the client via the network; and presenting the content to the user at the client.

In the same field of endeavor, Chen, related System And Method For Providing On-line Advertising And Information, discloses, e.g., in the tracking user browsing sites online art, that transmitting via a network the collected information from the client to a location (*Chen, Fig. 1, database server 30*) for generating a user profile for the user based on the collected information, wherein content is selected for the user based on the generated user profile (*Chen, the code transmission/receipt module 80 of the Internet device 14 sends the consumer code to the previously stored user' consumer profile*).

Accordingly, the Internet device 14 connects to the server of the online radio programming that is directed toward the user's interests, (col. 13, lines 40-45))

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Mathai's teachings of the user profile of his/her interest and usage patterns (*Mathai, Abstract, col. 4, lines 26-30; col. 5, lines 24-63*) with the teachings of Chen, for the purpose of providing the targeting power of the advertisements more progressively, more efficient and effective (*Mathai, col. 5, lines 53-62*). Chen also suggests that providing on-line advertising and information to a user connected to a data network. The system receives and plays the on-line

advertising or information while the user waits for an Internet call to be established between the user and the receiving party (Chen, col. 2, lines 12-19).

Chen discloses receiving the content at the client via the network (*Chen, receiving information and/or ads from the server system, Abstract*); and

Chen discloses presenting the content to the user at the client (*Chen, playing stored ads, Fig. 15, item 610; Fig. 16, item 740; Fig. 17, item 830; Fig. 18, item 925*).

9. As to claim 2, Mathai-Chen teachings as applied on claim 1 above, further teaches, wherein the information about the user includes information relating to network utilization behaviors (*Chen, network traffic, bandwidth availability*) and attributes (*Chen, Fig. 4*) of the user (*Chen, the flow controller 82 can control the flow of advertisement information uploaded to the Internet device 14 and affect the efficiency of transmitting information, (col. 9, lines 42-54; col. 14, lines 6-67)*) and wherein the navigation behavior includes information of domains visited by the user, the numbers of pages viewed by the user and time spent by the user at a site (*Mathai, col. 5, line 24 – col. 6, line 20*).

10. As to claim 3, Mathai-Chen teachings as applied on claim 1 above, further teaches, wherein the user profile of the user includes model generated information (*Chen, categorized information and/or advertisement information*) (*Chen, in Fig. 4, showing the different models and/or groups based on age group, income levels, hobby or interest*).

11. As to claim 4, Mathai-Chen teachings as applied on claim 1 above, further teaches, wherein the content includes one or more rules (*Chen, categories*) for

controlling the presentment of the content to the user at the client (*Chen, the user makes the selection of presenting the advertisement information, (Fig. 12, item 310; col. 11, lines 3-38)*).

12. As to claim 5, Mathai-Chen teachings as applied on claim 1 above, further teaches, wherein the information transmitted to the location includes an identifier (*Chen, consumer code or number*), and wherein at least a portion of the content is selected based on the identifier (*Chen, Fig. 4, ads are selected based on consumer code*).

13. As to claim 6, Mathai-Chen teachings as applied on claim 1 above, further teaches, wherein a fee is generated when the content is selected, and wherein the fee is charged to a party associated with the selected content (*Chen, the advertisers and on-line radio stations using this service would be charged by the Internet telephony service provider for advertising or on-line radio time. Accordingly, the user is assessed lower per-minute toll charges, or no charges, by the Internet telephony service provider to place Internet telephony calls, (col. 17, lines 50-57)*).

14. As to claim 7, Mathai-Chen teachings as applied on claim 1 above, further teaches, wherein the user accesses sites coupled to the network utilizing a first application (*Chen, telephone application*) hosted by the client, and wherein the content is presented utilizing a second application (*on-line radio stations or advertisement application*) hosted by the client (*Chen, Figs. 1, 5*).

15. Claims 8-14 are similar limitations of claims 1-7; therefore, they are rejected under the same rationale as in claims 1-7.

Art Unit: 2142

16. Claims 15-21 are similar limitations of claims 1-7; therefore, they are rejected under the same rationale as in claims 1-7.

17. Claim 22 is corresponding system in means plus function as claim 1; therefore, it is rejected under the same rationale as in claim 1.

18. Claims 23-29 are similar limitations of claims 1-7; therefore, they are rejected under the same rationale as in claims 1-7.

19. Claims 30-36 are similar limitations of claims 1-7; therefore, they are rejected under the same rationale as in claims 1-7.

20. Claims 37-43 are similar limitations of claims 1-7; therefore, they are rejected under the same rationale as in claims 1-7.

21. Claim 44 is corresponding system in means plus function as in claim 23; therefore, it is rejected under the same rationale as in claim 23.

22. Claim 45 is similar limitations of claims 1-5, 7; therefore, it is rejected under the same rationale as in claim 1-5, 7.

23. Claim 46 is similar limitations of claim 45; therefore, it is rejected under the same rationale as in claim 45.

24. Claim 47 is similar limitations of claim 45; therefore, it is rejected under the same rationale as in claim 45.

25. Claim 48 is similar limitations of claim 45; therefore, it is rejected under the same rationale as in claim 45.

26. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

Response to Arguments

27. Applicant's arguments filed 29 April 2005 have been fully considered but they are not persuasive.

28. In the remark, Applicant argued in substance that:

Point (A), Applicant points out that, "the term "logic" may be include circuitry, software, and/or a combination of circuitry and software" in claims 8-14, 30-36 and 46.

As to point (A), even though Applicant amended the claims by adding the element of "a processor", the processor does not execute the elements of logic which when read in light of specification amounts to nothing more than computer void of computer readable medium. See MPEP 2106(IV)(B)(1). Therefore, the logic is still read as software embedded in computer readable medium.

Point (B), the prior art does not disclose, "the information about the user including navigation behavior of the user, the navigation behavior being monitored at the client" in independent claims.

As to point (B), Mathai discloses in Fig. 1 that updating the user profile and usage history to reflect user interest and usage patterns for the purpose of targeting the advertisement marketing effectiveness (See Mathai, Abstract).

Art Unit: 2142

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
Art Unit 2142

Attn:

Beatriz Prieto
BEATRIZ PRIETO
PRIMARY EXAMINER